

SUBJECT: DECISION ON TERMINAL DISCLAIMERS INFORMAL FORM

DATE: 2-5-03

APPL. S.N.: 091 412,100

TO EXAMINER: H. Robinson

ART UNIT: 1653

MOSE MONTGOMERY, ROOM 11E18

MAILROOM DATE 1-27-03

AFTER FINAL YES ☒ NO ☐ NUMBER OF T.D(S). FILED 1

INSTRUCTIONS: I have reviewed the submitted T.D. with the results as set forth below. If you agree, please use the appropriate form paragraphs identified by this informal memo in your next office action to notify applicant about the T.D. If you disagree with my analysis or have questions at all about the acceptability of the T.D., please see me or our Special Program Examiner. THIS MEMO IS AN INFORMAL, INTERNAL MEMO ONLY. IT MUST NOT BE MAILED TO APPLICANT, NOR SHOULD A COPY BE LEFT IN FILE.

☐ The T.D. is PROPER and has been recorded. (See 14.23).

☒ The T.D. is NOT PROPER and has not been accepted for the reason(s) checked below. (See 14.24).

☐ The recording fee of \$ _____ has not been submitted nor is there any pre authorization in the application file to charge to a deposit account. (See 14.26.07)

☐ Application Examiner has not processed T.D. fee. (See fee authorization).

☐ The T.D. does not satisfy Rule 321(b)(3) in that the person who has signed the T.D. has not stated his/her interest (and/or the extent of the interest of the business entity represented by the signature) in the application/patent. (See 14.26 and 14.26.01).

☐ The T.D. lacks the enforceable only during the common ownership clause needed to overcome a double patenting rejection, Rule 321(c). (See 14.27, 14.27.01).

☐ It is directed to a particular claim(s), which is not acceptable since "the disclaimer must be of a terminal portion of the term of the entire patent to be granted". MPEP 1490. (See 14.26, 14.26.02).

☐ The person who signed the terminal disclaimer:

☐ has failed to state his/her capacity to sign for the business entity, (See 14.28).

☐ is not recognized as an officer of the assignee, (See 14.29 and possibly 14.29.01).

☐ No documentary evidence of a chain of title from the original inventor(s) to assignee has been submitted, nor is the reel and frame specified as to where such evidence is recorded in the office. 37 CFR 3.73(b). (See 1140 O.G. 72). **NOTE:** This documentary evidence or the specifying of the reel and frame may be found in the T.D. or in a separate paper submitted by applicant. (See 14.30).

☐ No "statement" specifying that the evidentiary documents have been reviewed and that, to the best of the assignee's knowledge and belief the title is in the assignee seeking to take action. 37 CFR 3.73(b). (See 1140 O.G. 72) (See 14.31).

☐ The T.D. is not signed. (See 14.26, 14.26.3). or 14.26.03 if TD is not signed by all the owners.

☐ Attorney not of record in oath/decl. or a separate paper filed appointing a new or associate attorney. (See 14.29.01).

☒ The serial number of the application (or the number of the patent) which forms the basis for the double patenting is missing or incorrect. (See 14.32).

☐ The serial number of this application (or the number of the patent in reexam or reissue case(s) being disclaimed is missing or incorrect. (See 14.26, 14.26.04 or 14.26.05).

☐ The period disclaimed is incorrect or not specified. (See 14.27, 14.27.2 or 14.27.3)(For Samples 14.27.04 and 14.27.05)

☐ Other: _____

☐ Suggestion to request refund of \$ _____. (See 14.35, 14.36).

☐ **EXAMINER NOTE: IF APPLICATION IS IN CONDITION FOR ALLOWANCE ANY OF THE ABOVE INFORMALTIES MAY BE FAXED IN TO THE GROUP**

FOR SAMPLE TERMINAL DISCLAIMERS AND CERTIFICATES:

☐ Sample of a TD over a pending application and assignee Certificate (See 14.37).

☐ Sample of a TD over a prior patent and assignee Certificate (See 14.38).

☐ Sample Assignee Certificate under 37 CFR 3.73 (b) (See 14.39)



EXPRESS MAIL CERTIFICATE

RECEIVED

JAN 30 2003

TECH CENTER 1600/2900

DOCKET NO. : 21829/240 (EBC-002)

APPLICANTS : Zhong-Min Wei, Hao Fan, Jennifer J. Stephens, Steven V. Beer,
and Ron Laby

TITLE : **HYPERSENSITIVE RESPONSE ELICITOR FRAGMENTS
WHICH ARE ACTIVE BUT DO NOT ELICIT A
HYPERSENSITIVE RESPONSE**

Certificate is attached to the **Terminal Disclaimer To Obviate A Provisional Double Patenting Rejection Over A Pending Second Patent Application (2 pages) (in duplicate)** of the above-named application.

"EXPRESS MAIL" NUMBER: EV 139569569US

DATE OF DEPOSIT: January 27, 2003

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the U.S. Patent and Trademark Office, P.O. Box 2327, Box: CPA, Arlington, VA 22202.

Andrew K. Gonsalves

(Typed or printed name of person mailing
paper or fee)

(Signature of person mailing paper or fee)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Wei et al.
Serial No. : 09/412,100
Cnfrm. No. : 9211
Filed : October 4, 1999
For : HYPERSENSITIVE RESPONSE ELICITOR
FRAGMENTS WHICH ARE ACTIVE BUT
DO NOT ELICIT A HYPERSENSITIVE
RESPONSE



Examiner:
H.A. Robinson

Art Unit:
1653

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**TERMINAL DISCLAIMER TO OBVIATE A PROVISIONAL DOUBLE
PATENTING REJECTION OVER A PENDING SECOND PATENT APPLICATION**

U.S. Patent and Trademark Office
P.O. Box 2327
Arlington, VA 22202
Box: CPA

Dear Sir:

Petitioners, Cornell Research Foundation, Inc., and EDEN Bioscience Corporation, are collectively the owners of 100 percent interest in the instant application. Petitioners hereby disclaim, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. §§ 154 to 156 and 173 as presently shortened by any terminal disclaimer filed prior to the grant of any patent granted on pending second Application Number 09/086,118, filed May 28, 1998, of any patent on the pending second application. Petitioner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and any patent granted on the second application are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, petitioner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. §§ 154 to 156 and 173 of any patent granted on the second application, as shortened by any terminal disclaimer filed prior to the patent grant, in

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the event that any such granted patent: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR § 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer filed prior to its grant.

The assignees of the entire right, title and interest of the above-identified application, hereby confirm that assignments for the subject application were recorded on November 22, 1999, at Reel 010407/Frame 0931, and on May 9, 2002, at Reel 012889/Frame 0927, in the U.S. Patent and Trademark Office.

The undersigned has reviewed all the documents in the chain of title of the patent application identified above and, to the best of undersigned's knowledge and belief, title is in the assignee identified above.

For submission on behalf of an organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned (whose title is supplied below) is empowered to act on behalf of the organization.

Please charge the \$110.00 terminal disclaimer fee under 37 CFR § 1.20(d) as well as any additional fees or credit any overpayment to Deposit Account No. 14-1138. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

Date:

January 27, 2003



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Registration No. 30,727
Attorney for Applicants

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